

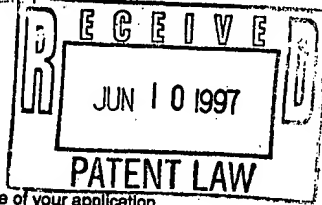


UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trade Mark Office  
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Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/444,790	05/19/95	BROCKHAUS	M 9189

GEORGE M GOULD  
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MUTLEY NJ 07110

18M1/0506



EXAMINER
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EISENSCHENK, F	
ART UNIT	PAPER NUMBER

1816

DATE MAILED:

08/06/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on \_\_\_\_\_

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 4445-47, 55-56 is/are pending in the application.  
Of the above, claim(s) 55 is/are withdrawn from consideration.  
☒ Claim(s) 45, 56 is/are allowed.  
☒ Claim(s) 44, 46, 47 is/are rejected.  
☐ Claim(s) \_\_\_\_\_ is/are rejected.  
☐ Claim(s) \_\_\_\_\_ is/are objected to.  
\_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.  
☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.  
☐ The specification is objected to by the Examiner.  
☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.  
☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892  
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  
☐ Interview Summary, PTO-413  
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948  
☐ Notice of Draftsperson's Patent Application, PTO-152

RESPONSE TO FINAL REJECTION & NOTICE OF APPEAL DUE: <u>Sept. 6, 1997</u>
STATUTORY PERIOD EXPIRES: <u>Sept. 6, 1997</u>

Department PLP

-SEE OFFICE ACTION

Best Available Copy

15. Please note the examiner and Art Unit handling this case has changed. Please direct all further communications to the below named examiner.
16. Claims 1-43 and 48-54 are canceled.
17. Applicant's election without traverse of in Paper No. 8 is acknowledged. Claim 55 is withdrawn from consideration as drawn to a non-elected invention.
18. Applicant's request to withhold the filing of formal drawings until an indication of allowable subject matter is acknowledged.
19. Claim 45 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 45 should be amended to replace "contains" with -- has --. The sequence of Figure 1 appears to encode the entire 55 kDa protein, therefore an insoluble protein as claimed will have the amino acid sequence of Figure 1 and not contain it. Applicants' comments with respect to the traversal of the rejection are noted. Applicant apparently believes that the scope of the claim includes any other amino acids which do not alter the characteristics which are recited within claim 44 and that the claim is not indefinite. The specification provides not reaching or guidance with respect to what amino acids can be included without altering the recited properties nor is it clear from the specification how much deviation is allowed by the recitation of "about 55Kd". Does the scope of the claim allow for deviation of 1, 5, 10, or 20 Kd or does the recitation allow for the addition of 1, 5, 10, or 20 amino acids. Clarification is requested.
20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371<sup>c</sup> of this title before the invention thereof by the applicant for patent.
21. Claims 44 and 46 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. [U.S. Patent No. 5,395,760]. Smith et al. teach a 55 kDa tumor necrosis factor receptor protein, DNA and expression vectors encoding the receptor. *Applicant appears to argue that the reference is inapplicable in view of alleged prophetic examples. At issue is whether the patent places the invention within the grasp of the public. It is the Examiner's position that the teachings of the patent enable one skilled in the art to arrive at the invention as now claimed.*

*Rejections predicated upon Wallach et al. are withdrawn in view of the teaching that the TNF binding protein has a molecular weight of 27,000 under both reducing and non-reducing conditions (see Wallach et al., 5, 359,037, column 1, lines 55-65).*

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22. Claims 45 and 56 are allowable.
23. Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). THE CM1 FAX CENTER TELEPHONE NUMBER IS (703) 308-4242
24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Eisenschenk whose telephone number is (703) 308-0452. The examiner can normally be reached Monday through Thursday from 6:30 am to 5:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 180 receptionist whose telephone number is (703) 308-0196.



June 5, 1997  
Christopher Eisenschenk, Ph.D.  
Primary Examiner  
Group 1800